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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,978	08/21/2000	Norman William MacLeod	P0557/7030	6678

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EXAMINER

LEE, EDMUND H

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 07/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/581,978

Applicant(s)

MACLEOD, NORMAN WILLIAM

Examiner

EDMUND H LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) 24-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's Preliminary amendment filed 8/21/00 has been entered. In accordance with Rule 126, the new claims of the above amendment have been renumbered as claims 21-40 instead of claims 22-41. The last claim in the instant application prior to the filing of the above amendment was claim 20.

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 21-23, drawn to a method of making an item of footwear.

Group II, claim(s) 24-40, drawn to an apparatus for making an item of footwear, and a last for making an item of footwear.

3. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group I unlike Group II does not require a means for heating the base of the body of the forming last.

4. During a telephone conversation with Doug Wolf on 6/28/02 a provisional election was made with oral traverse to prosecute the invention of Group I, claims 21-23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 24-40 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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5. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

6. Claims 21-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "-such as a shoe or a boot" (cl 21, lns 1-2) renders the claim indefinite because it is unclear whether the limitations following the phrase "such as" are part of the claimed invention. See MPEP § 2173.05(d).

Clarification and/or correction is required.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Hardy (USPN 2878523). Hardy teaches the claimed method including a method of making an item of footwear such as a shoe (figs 7-8); forming an upper for the item of the footwear on a forming last (col 2, lns 5-23; figs 7-8); using a last including a body having the general shape of a foot around which the upper is to be formed, wherein the body has a base corresponding to a sole of the foot shape (figs 7-8); molding a rubber sole onto the formed upper while it is still mounted on the forming last, wherein the forming last is heated before and during the molding step (col 5, lns 32-35; col 9, ln 70-col 10, ln 2; figs

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7-8); and heating the base of the last body while substantially preventing the heating of the parts of the body other than the base (col 12, lns 70-col 13, ln 3; figs 7-8).

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardy (USPN 2878523) as applied to claim 21 and further in view of Foffano et al (USPN 5955017). The above teachings of Hardy are incorporated hereinafter. Hardy also teaches placing the last with the upper thereon adjacent a mold assembly having a plurality of mold parts (figs 7-8); arranging the mold parts adjacent the base of the last and the upper thereon to define a mold cavity for the rubber sole (figs 7-8); placing a sole blank into the mold cavity (figs 7-8); applying heat and pressure to the rubber sole blank in the cavity to form the sole in adherence to the upper (col 11, ln 71-col 12, ln 8; figs 7-10); and heating the mold parts before and/or during the formation of the rubber sole to vulcanize the rubber (col 6, lns 29-53; col 9, ln 70-col 10, ln 2). However, Hardy does not teach injecting the rubber. Foffano et al teach a method of making an item of footwear (figs 1-6); injecting rubber into a mold cavity formed by a plurality of mold parts including a last having an upper thereon (col 2, lns 60-67; figs 1-6); and using heat and pressure applied to the rubber to form the sole (col 4, lns 3-col 6, ln 8; figs 1-6). Hardy and Foffano et al are combinable because they are analogous with respect to making

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footwear by heating and pressuring rubber against a last having an upper thereon.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to inject rubber as taught by Foffano et al instead of placing a rubber blank into the mold cavity of Hardy in order to reduce the cycle time of the molding process of Hardy.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tusa et al (USPN 3441643) teach injection molding a sole onto an upper which is placed on a heated last.


12. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Examiner Edmund Lee whose telephone number is (703) 305-4019. The examiner can normally be reached on Monday-Wednesday and Friday from 8:00 AM to 4:00 PM. The fax number for Examiner Edmund Lee is (703) 872-9615

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan H. Silbaugh, can be reached on (703) 308-3829.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

EHL

June 29, 2002


Edmund Lee
6/29/02
Patent Examiner, AU 1732